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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/209,454 | 12/11/1998 | HIDENARI TANAKA | 88125/ASAHIIN | 6958 |
| 23548 | 7590 | 04/21/2004 | EXAMINER | |
| LEYDIG VOIT & MAYER, LTD 700 THIRTEENTH ST. NW SUITE 300 WASHINGTON, DC 20005-3960 | | | | LASTRA, DANIEL |
| ART UNIT | | PAPER NUMBER | | |
| | | | | 3622 |

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|----------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/209,454 | TANAKA ET AL. <i>MW</i> | |
| | Examiner | Art Unit | |
| | DANIEL LASTRA | 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 06 February 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 17-22 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 17-22 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 17-22 have been examined. Application 09/209,454 (~~METHOD OF SELLING CONTACT LENS~~) has a filing date 12/11/1998 and foreign priority date 12/12/1997.

Response to Amendment

2. Applicant filed an RCE 02/06/04. Applicant amended claims 17-21 and added new claim 22. Applicant amendment did put claims 17-22 in condition for allowance.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-22 are rejected under 35 U.S.C. 101 because based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A single claim which claims both an apparatus and

the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17. USPQ2d 1548 (Bd. Pat. App. & Inter. 1990)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauly et al (U.S. 4,958,280) in view of Fay (U.S. 5,983,201) and further in view of Eberhardt (U.S. 5,659,741).

As per claim 17, Pauly et al teach:

A method of selling prescription contact lenses said method comprising:

transferring *contact lens* customer identification, address, and diagnostic data pertaining to a respective *contact lens* customer from said plurality of second group information processing apparatus to said first group information processing apparatus through the communication network (see column 2, line 35 – column 3, line 5; column 3, line 36 – column 4, line 38; column 5, lines 4-18; column 6, lines 11-33);

assigning a registration number to the customer and storing the registration number assigned in relationship with the customer identification and diagnostic data transferred to the *contact lens seller* (see column 6, lines 39-45);

Pauly fails to teach:

providing the registration number assigned and selling agent data for a selling agent closest in geographical relation to the customer based on the *contact lens* customer address data, from the contact lens *seller* to the *contact lens* customer, through the communication network;

delivering a contact lens from the selling agent to the *contact lens* customer; and

transferring delivery data from the selling agent to the contact lens *seller* through the communication network.

However, Fay teaches:

providing the registration number assigned and selling agent data for a selling agent closest in geographical relation to the customer based on the customer address data, from the contact lens provider to the customer, through the communication network (see column 5, line 55 – column 6, line 54);

delivering a contact lens from the selling agent to the customer (see column 6, lines 35-54); and

transferring delivery data from the selling agent to the contact lens provider through the communication network (see column 6, lines 48-54).

Although the Fay system relates to the selection of eyeglass frames and not to contact lenses, it can be used to view, select, and purchase other related products (see column 9, lines 4-8). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly system would deliver the purchase product, in this case contact lenses, to a selling agent that would take care

of delivering the product to the customer, as taught by Fay. Therefore, if the selling agent is an optical retail store (see Fay column 6, lines 35-40), the customer would go to that store to pick up the product and this way he/she would save the shipping and handling charges.

Pauly fails to teach a method of selling prescription contact lenses using a system comprising: a first group information processing apparatus and *located at a facility of a contact lens seller*, a plurality of second group information processing apparatus, *each second group information processing apparatus being located at a respective facility of a contact lens prescriber*, the plurality of second group information processing apparatus being connected through a communication network to the first group information processing apparatus, and portable recording media for recording data and registration numbers, so that the first group information processing apparatus can determine an exchange time for exchanging a contact lens, based on date of issuance of the contact lens and characteristics of the contact lens, whereby information notifying a contact lens customer to whom a contact lens was issued of the exchange time of the contact lens, may be given at the exchange time, both the first group information processing apparatus and the plurality of second group information processing apparatus writing data on portable recording media, each recording medium being used by only one corresponding contact lens customer. However, Eberhardt teaches a portable recording media that stores patient's medical data, such as prescription information, expiration date, date of purchase, refills and prescription's date of completion (see column 3, lines 39-67; column 4, lines 50-53; column 14, lines 13-

36). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly would use a portable recording media, as taught by Eberhardt, to store contact lenses' prescription data. Storing medical information in a portable recording media would allow medical providers to obtain accurate information about patients even when patients are very ill, unconscious, unable to speak or ignorant about their medical status.

As per claim 18, Pauly teaches:

The method of Claim 17, including delivering notification of an approaching deadline to replace the contact lens from the contact lens *seller* to the *contact lens* customer through the communication network (see column 1, lines 46-65; column 7, lines 9-21).

As per claim 19, Pauly does not expressly teach:

The method of Claim 17, including offering new contact lenses to the *contact lens* customer in exchange for old contact lenses at irregular times, upon any of loss of transparency of the contact lenses, breakage of the contact lenses, and scratching or soiling of the contact lenses, and a monthly payment by the *contact lens* customer. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that even though a patient would have a set up wear schedule where it would receive new contact lenses according to a set up time, as taught by Pauly (see column 7, lines 10-21), if for whatever reason the patient breaks a contact lens or scratches it, even though he/she is not scheduled to receive new contact

lenses, he/she may choose to get them out of schedule because out of convenience, his or her preference and/or the better quality of vision provided by the contacts.

As per claim 21, Pauly teaches:

The method of claim 19, including contracting for a one year term with the respective *contact lens* customer for supplying long-term-use contact lenses in exchange for the old contact lenses and the monthly payment (see column 7, lines 9-48).

Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauly et al (U.S. 4,958,280) in view of Fay (U.S. 5,983,201) and further in view of the article Cashing in on quicker delivery times .

As per claim 20, Pauly fails to teach the method of Claim 17, including periodically offering for sale contact lens care articles by the contact lens *seller* to the customer through the communication network. However, the article Cashing in on quicker delivery times teaches about a system where the contact lens provider offers to its customers 99.99 percent on-time delivery of its product when using the contact lens provider ordering network and offers customers the option of ordering product direct from local distributors (see paragraphs 3-6). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly's customers would use the contact lens provider network system to order contact lens products and would receive products updates periodically, as taught by the article. This feature would give customers a reliable venue to obtain the products related to their contact lens care.

As per claim 22, Pauly fails to teach:

The method of claim 20, including periodically offering for sale the contact lens care articles based upon a consumption period of the contact lens care articles and date of most recent sale of the contact lens care articles to the respective contact lens customer transmitted from the first group information processing apparatus. Pauly teaches a system that changes the wear schedule and shipment of the contact lenses deliver to customers (see column 7, lines 9-11). And as explained in claim 20, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly's customers would use the contact lens provider network system to order contact lens products and would be able to change the wear schedule and shipment schedule, as taught by Pauly. This feature would give customers a reliable venue to obtain the products related to their contact lens care.

Response to Arguments

6. Applicant's arguments filed 08/19/03 have been fully considered but they are not persuasive. Applicant argues that amended claim 17 describes a method employing a portable recording media where a particular contact lens customer can change between contact lens prescribers readily, without assistance of the prescribers and that neither Pauly nor Fay provides these important features.

The Examiner answers that the Applicant is arguing about features that are not in the claims. Claim 17 recites "a method of selling prescription contact lenses..., said method comprising: transferring contact lens customer identification....transferring delivery data from the selling agent to the contact lens seller through the communication

network." Nowhere, in the step of the method the Applicant mentioned a portable recording medium.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
April 14, 2004

M. Keny
MELANIE A. KENYER
PRIMARY EXAMINER